

Patent
706737.29
(257/087)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

MARK C. DOYLE

Serial No.: 09/724,657

Filed: November 28, 2000

**For: PASSIVE NEEDLE GUARD FOR
SYRINGES**

Group Art Unit: 3763

Examiner: A. Lam

11/15/03

After Final

REQUEST FOR RECONSIDERATION

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action dated December 3, 2002, in which the Examiner finally rejects all of the existing Claims 1 through 24. The purpose for requesting reconsideration is that it is believed that the Examiner has not fully considered the details of the existing claims and the differences recited in the claims as compared to the Righi patent. It seems that it would be a waste of both the Examiner's time and Applicant's time in pursuing an appeal in this application if the present issues can be resolved.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office Fax. No. (703) 305-3590 on January 6, 2003.

January 6, 2003
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Jodie Davis

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Stated simply, the Righi patent discloses (1) a specially designed syringe for containing a medicine to be injected, and (2) a cooperating shield 12. The Examiner contends that this syringe is the "body" in the claims; however, that syringe (or "body") does not have or receive a medicine cartridge as claimed.

In contrast, the present application is directed to a method and device for use with a medicine cartridge which can be a conventional syringe containing the medicine to be injected and does not have to be a specially designed syringe. Thus, the present invention is directed to a method and apparatus involving (a) a body for containing or receiving, (b) a medicine cartridge, and (c) a shield cooperating with the body. The Righi patent simply does not have this combination. The Examiner reads the syringe of Righi as two of applicant's claimed elements – namely, the body and the medicine cartridge. It is respectfully believed that this is an improper reading.

The Examiner's attempted reading of claims on Righi ignores the fact that Applicant's invention and claims involve these three components (a), (b) and (c); whereas, Righi only has two. The Examiner contends that "the medicine cartridge is not defined structurally in the claims," which it is submitted is incorrect. Independent Claim 1 specifically defines a method for performing an injection using a passive needle guard "including a body having a medicine cartridge therein," a needle extending from the cartridge, a plunger communicating with the cartridge, and further actions of what occurs upon depression of the plunger. Independent Claim 10 has similar recitations with regard to the medicine cartridge, needle and plunger. Apparatus independent Claim 14 defines a body with a cavity therein "for receiving a medicine cartridge having a distal tip for administering a medication from within the cartridge," as well as other specific recitations with regard to the

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cartridge. The Examiner contends that element 1 of Righi is the body but it is clear from the disclosure in the Righi patent that this "body" is not designed to, nor can it, receive a medicine cartridge with a distal tip, plunger, etc., as specifically defined in Claim 14.

It is respectfully submitted that it is believed that the Examiner has overlooked these important and specific limitations in the present claims, and that Righi simply does not have any disclosure of a body having a medicine cartridge or for receiving a medicine cartridge as well as a shield cooperating with that body in the manner defined in the present claims.

Accordingly, favorable reconsideration is requested.

The Examiner is encouraged to telephone the undersigned (Direct: 949/852-7790) if it may help in expediting the prosecution of this application.

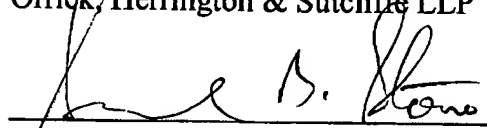
A Revocation & Power of Attorney is enclosed herewith.

The Commissioner is authorized to charge Counsel's Deposit Account No. 150665 for any additional fees that may be required and to credit any overpayments to said Deposit Account 150665.

Dated: 1-6-03

Respectfully submitted,
Orrick, Herrington & Sutcliffe LLP

By:


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